

REMARKS

This amendment responds to the office action mailed September 15, 2003. In the office action the Examiner:

- rejected claims 4, 5, and 16 as being indefinite under 35 U.S.C. 112, second paragraph;
- rejected claims 1-25 under 35 U.S.C. § 103 as being unpatentable over Mayaud, U.S. Patent No. 5,845,255 in view of PR Newswire nevoca.com Enhances Prescription Verification System.

New claims 26-30 have been added, in which no new matter has been added. Support for the new claims can be found throughout the specification, including the drawings, and claims as originally filed.

After entry of this amendment, the pending claims are: claims 1 and 3-30.

Claim Rejections - 35 USC § 112

The Examiner has rejected claims 4, 5, and 16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleges there is insufficient antecedent basis for the claim limitation "said electronic prescription renewal request" in claim 4 as well as for the claim limitation "said electronic renewal prescription" in claim 16. Claim 15 is rejected based on its dependency from rejected claim 4.

Claims 4, 15, and 16 have been amended to correct these claims as filed. The term "electronic" has been deleted from claim 4, 15, and 16. Accordingly, the Examiner is respectfully requested to reconsider these claims.

Claim Rejections - 35 USC § 103

The Examiner has rejected claims 1-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,845,255 to Mayaud (hereinafter "Mayaud") in view of PR Newswire, nevoca.com Enhances Prescription Verification System (hereinafter "nevoca").

To establish a prima facie case of obviousness, three basic criteria must be met, namely:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.¹

The rejected claims (claims 1-25) include three independent claims, namely claims 1, 22, and 24. The Examiner has rejected claims 1-25 under 35 U.S.C. § 103 as being unpatentable over Mayaud, U.S. Patent No. 5,845,255 in view of PR Newswire, nevoca.com Enhances Prescription Verification System.

The Examiner has alleged that:

Mayaud teaches a method for renewing a prescription for a pharmaceutical via an electronic network, comprising the steps of: generating a prescription renewal request for the renewal of a prior prescription (see column 19, lines 48-53 and lines 63-67); receiving a renewal prescription, in response to said prescription renewal request from a prescriber (see column 20, lines 50-60); and notifying a dispenser to fill said renewal prescription (see column 20, lines 5-11 and column 32, lines 23-25).²

The Examiner has also alleged that:

...while Mayaud appears to teach transmission of the renewal request via face-to-face interaction between patient and prescriber, it is unclear exactly how the patient requests the prescription renewal. Nevoca teaches a system for electronically communicating prescription renewal requests to doctors as a result of call-in or walk-in requests (see paragraph 7) (emphasis added).³

¹ See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

² See Office Action dated September 15, 2003, page 3.

³ *Id.*

The system of Mayaud “compile[s] what may be termed a “virtual” patient record from multiple remote databases of primary source information”⁴ and allows members, such as doctors, or other health providers or organizations to access, update, retrieve, and study a patient’s history to enhance health treatment. During use of the Mayaud system, the doctor selects a particular patient for review of the patient’s history and “the selected patient’s prescription history are listed in patient history zone 43 in the middle of the screen for convenient review by the physician-user...”⁵

In other words, the system disclosed and taught in Mayaud requires the doctor to select a patient that he/she is interested in reviewing, access or retrieve that patient’s medical and prescription history, and thereafter, update or renew a prescription. Conversely, the present application teaches and claims a system that conducts computer monitoring of an expiration date of a prescription, generates a prescription renewal request prior to the expiration date based on the computer monitoring, transmits the prescription renewal request to a prescriber for her/his review and/or renewal, receives a renewal prescription from the prescriber in response to the prescription renewal request, and notifies a dispenser to fill the renewal. All steps occur automatically without user or patient intervention.

The Examiner relies on nevoca for allegedly teaching “a system for electronically communicating prescription renewal requests to doctors as a result of call-in or walk-in requests...”⁶ Nevoca, however, does not disclose, teach, or suggest any type of system providing computer monitoring of an expiration date of a prescription as disclosed and claimed in the present application. Accordingly the combination of Nevoca and Mayaud does not teach, disclose, or suggest all the limitations of independent claims 1, 22, and 24. In light of the above, it is respectfully submitted that claims 1-25 are now in condition for allowance and patentable over the cited prior art.

⁴ See U.S. Patent No. 5,845,255 to Mayaud at column 8, lines 34-37.


⁵ *Id.* at column 19, lines 63-67.

⁶ See Office Action dated September 15, 2003, page 3.

In light of the above amendments and remarks, the Applicants respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is encouraged to call the undersigned attorney at (650) 849-7627, to help resolve any remaining issues.

Date: January 15, 2004

Respectfully submitted,


Shawn C. Glidden 51,743
for Francis E. Morris (Reg. No.)
24,615
Morgan Lewis & Bockius LLP
3300 Hillview Avenue
Palo Alto, California 94304
(650) 493-4935